

## **REMARKS**

The above Amendments and these Remarks are in reply to the Final Office action mailed 5 Jan 2009. An RCE is submitted herewith, as is the fee for an appropriate Extension of Time.

Claims 1-103 were pending in the Application prior to the outstanding Office Action. The present Response amends claim 74 and adds claim 104, leaving for the Examiner's present consideration, claims 1-104. Reconsideration of the rejections is requested.

### **I. REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Office action maintains the previous Section 103(a) rejections of all of the claims under 35 U.S.C. § 103(a) as being unpatentable in view of prior art, in particular, Christopher (US 6900980), Kaltenecker et al. (US 6816277), Jones (US 2002/0118949), Jeong et al. (US 6690878), Torres et al. (US 6738075), and Falcon (US 7222207). Specifically, claims 1-31, 38, 40, 42, 45-67, 74-85, 89, 92-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher in view of Kaltenecker, and all the other pending claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher, Kaltenecker, and either Jones, Jeong or Torres.

Applicants will address the claims in sequence.

#### **A. Independent Claim 1**

Claim 1 calls for at least the memory, display and communications interface, all to be within a "portable" memory device, be supported by "a substrate", and to fit within a bounding box having specified maximum dimensions.

The Examiner cites Christopher as teaching the above elements. Specifically the Examiner identifies Christopher's memory 414 and storage device 418 as constituting Applicants' "memory". The Examiner also identifies Christopher's entire PC 410 as including Applicants' "display", and further identifies Christopher's cradle 420 as representing Applicants' "communications interface". Thus according to the Examiner's characterizations, these three separate items of Christopher, two of which are large, heavy and awkward enough that it would be difficult for one person to lift them together, much less drop them in a shirt pocket to carry around, constitute the "portable memory device" called for in Applicants' claim.

The Examiner cites no reference teaching the portability and size limitations of the claim,

but rather cites *In re Rose*, 105 USPQ 237 (CCPA 1955) for the proposition that "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention".

In Applicants' Response A, Applicants pointed out that, first, the limitation that the memory device be "portable" is not a size limitation; and second, *Rose* does not sanction ignoring the size limitation altogether. Rather, even the *Rose* court goes on to analyze the size limitation for obviousness.

In the Final Office Action, the Examiner responds by quoting language in MPEP 2144.04(IV)(A), second paragraph, that "where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device" (citing *Gardner v. TEC Systems, Inc.*, a 1984 Federal Circuit case).

The Examiner takes from this that since Applicants' claimed portability and size limitations do not affect the "functionality" of the device, the claimed device is not patentably distinct from the prior art device. The Examiner considers the "core functionality" of Applicants' claimed device to be the ability to connect to multiple hosts and convert image formats.

**Initially, Applicants respectfully disagree that this is "the core functionality" of Applicants' claimed device**, or that any claimed device can have a "core functionality". The Federal Circuit long ago rejected the idea that a claimed invention has a legally recognizable 'essential', 'gist', or 'heart', since that would violate the principle that a claim must be evaluated as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). No limitation in a claim is any more or less "core" than any other limitation.

Applicants submit that one "functionality" of their invention as described in claim 1, which is just as "core" as converting image formats, is that it can be held in a user's hand, and carried around and shared just as a collection of photos are shared today -- except that an embodiment of the invention can store many more photos. See, for example, the following excerpts from Applicants' specification:

[0005] It would be desirable to be able to instantly share digital photographs and video clips as easily as one conventionally shares a photo print, such as a Polaroid picture, but without the paper or chemicals: the image develops instantly, it is immediately

removable from the camera, it is immediately viewable without any additional machinery, it is easily sharable with friends and business associates, and it is small and light enough to be carried around in a shirt pocket.

[0008] .... The portable memory device can assume many physical form factors as the architecture is scalable but the preferred embodiment will fit in your hand for easy sharing, or in a shirt pocket, purse, wallet, or desktop intelligent cradle system capable of interfacing with a multitude of electronic devices to transfer and exchange image files.

[0009] In consumer applications, there is a craving to immediately view still images and video footage to share both individually and also communally without the camera. .... The small form factor facilitates portability because several will fit into a shirt pocket, wallet, purse, or briefcase.

[0033] .... Preferably the device 210 is small and thin enough to be carried around in a shirt pocket. The device should in particular be thin enough to fit within various slots as described hereinafter, and for marketing purposes it is advantageous for the device to be of a size that users generally associate with familiar portable memory devices or familiar PCMCIA or SmartMedia devices. (emphasis added)

Thus "shirt pocket portability", which could be achieved in a device having the claimed dimensions, must be considered to be one of the "core functionalities" of the invention as called for in claim 1. As such, the Examiner's assertion that Applicants' claimed portability and size limitations cannot support patentability really does not apply.

**Second, even *In re Rose* does not prohibit the use of size limitations as patentable distinctions.** Rose's language is that the size of an article is not "ordinarily" a matter of invention. That is, the language admits that some circumstances might exist in which size is a matter of invention.

**In fact, in at least some patents subsequent to *In re Rose*, the size of an article was held to have been sufficient to distinguish over the prior art.** As one example, see *Ex parte Dunbar*, Appeal No. 1998-0560 in Application 08/527,957 (BPAI 2000). This Board of Appeal opinion is not precedential but is still valuable as persuasive and informative authority.

In *Dunbar* the claim called for a 3.5 inch diskette having a central hub which was smaller than the prior art 29mm diameter. The only limitation that distinguished the claim from the prior art was, "wherein the hub has a diameter of less than 29.0 mm".

The Examiner had rejected the claim on the ground that it would have been obvious to determine the size of the hub by routine experimentation. The Board reversed, reminding the Examiner that "Patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious once the source of the problem is identified", citing *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

**The question before the Examiner, therefore, is not whether a size limitation can make a claim patentable; clearly it can. The question is whether the claim as a whole, including the size limitation, would have been obvious.** However, the Office action cites no art that teaches or suggests any motivation or any other reason why it would have been obvious to modify Christopher's desktop computer system to fit within the size limitations called for in the claim. *In re Rose* does not supply such a motivation, since that is a court decision and cannot be used as prior art in an obviousness combination rejection.

Since no reason or motivation has been cited as to why such a modification of Christopher would have been obvious, Applicants respectfully submit that the Office action fails to satisfy the requirement in *KSR* that an obviousness rejection set forth a clear articulation of the reason(s) why the claimed invention would have been obvious. MPEP 2142. Without such a reason, the rejection fails to state a *prima facie* case of obviousness.

**In the present case, as in *Dunbar* and *Spinnoble*, unobviousness lies in part in Applicants' discovery of a problem in the prior art**, not necessarily in the discovery of the claimed solution. Even if the Examiner considers Applicants' claimed solution to have been obvious once a person of ordinary skill became aware of the problem to be solved, Applicants respectfully submit that Applicants' claim should be considered unobvious because the problem to be solved was unknown at the time. Discovery of the source of the problem is part of the 'subject matter as a whole' which always must be considered in determining the obviousness of an invention. *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

As explained in Applicants' specification for example in paragraphs [0005], [0008], [0009], [0033], it was Applicants' discovery of a need that was not being met by any other prior art: a latent and unexpressed craving to share digital photographs and video clips as easily as one conventionally shares a collection of printed photos, but to do so instantly, without paper or chemicals, and with the same shirt pocket portability as a collection of printed photos. None of the references in the outstanding Office action teaches or suggests this problem, and Applicants respectfully submit that

it would not have been obvious at the time of Applicants' invention.

Applicants' claimed combination to a portable device having a size no greater than the limitation stated in the claim, gives an embodiment of the system a whole new use: now it can be separated from the host camera (or other host), carried around in a shirt pocket, and shown to other people in the same way as a wallet full of photos can -- except with a hugely greater number of photos, videos, etc.

\* \* \* \* \*

At the risk of re-stating what the Examiner already knows, the Examiner is aware of the need to avoid hindsight when evaluating the obviousness of the size limitation of Applicants' claim. In the present case that means that just because the Examiner thinks it obvious to combine all the claimed limitations into a portable, shirt-pocket-sized device, does not mean it would have been obvious *at the time, and absent reading Applicants' specification*.

And while the claimed invention may seem obvious to the Examiner today, Applicants point out that obviousness must be measured as of the filing date of the application in 2003, when many of the devices that the Examiner may be familiar with did not exist. Nor is the Examiner permitted to consider as prior art, any information that is new in the subject application specification in determining obviousness. As of Applicants' filing date, it is respectfully submitted that it was not obvious to provide a portable memory device with a display, a communications interface a controller as described in Applicants' claim, all in a size that meets the size limitations called for in the claim.

**Accordingly**, Applicants respectfully submit that claim 1 should be patentable both because the Office action fails to recite a motivation or reason for modifying Christopher to satisfy Applicants' claimed size limitations, and also because even the problem addressed by the invention was unobvious at the time of Applicants' invention.

## **B. Dependent Claims 2-44**

The Examiner rejected these claims as being obvious over various combinations of Christopher, Kaltenecker, and either Jones, Jeong or Torres.

These claims all depend ultimately from independent claim 1, and therefore are believed to be patentable for at least the reasons set forth above with respect to independent claim 1. In

addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right.

For example, dependent **claim 3** adds a limitation that one of the hosts is "physically larger than the memory device." See the discussion below regarding claim 45 for Applicants' points why this limitation should render claim the claim patentable.

As another example, **claim 4** adds limitations calling for the controller to be further operable to determine a second image file format suitable for a second one of the hosts, and communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host.

The Examiner cites Christopher col. 3, lines 5-10 and 52-61 as teaching this feature, but nothing therein says anything about determining an image file format suitable for a host, nor communicating the image to that host according to the second image file format. The Examiner is respectfully requested to reconsider this rejection, or at least point out specifically where in these two excerpts Christopher teaches these two features. If the Examiner's argument is that they are *inherent* from Christopher, then it is respectfully requested that the Examiner follow the procedures set forth at MPEP 2112(IV) for making an inherency-based rejection.

As another example, **claim 9** adds a limitation that the controller be operable such that when operated to render on the display an image from the first host while the memory device is in communication with the first host, the image bypasses the memory.

The Examiner has cited nothing in any reference that teaches the rendering of an image from a host in a way that bypasses the memory. Applicants believe that actually would be quite unusual, in the Examiner's conception of Christopher. The Examiner is respectfully requested to reconsider this rejection.

As another example, **claim 14** adds a limitation that the first host comprise a digital camera.

The Examiner cites Christopher col. 3, lines 24-26 as teaching "other storage devices that use a memory card". But that is not what claim 14 calls for. Claim 14 calls for the host, not the memory, to comprise a digital camera. In the Examiner's conception, the host is Christopher's PDA, not his computer. Christopher nowhere teaches that his PDA comprises a digital camera. Again, the Examiner is respectfully requested to reconsider this rejection.

As another example, **claim 18** adds limitations calling for a particular one of the hosts to include a slot for receiving and holding a plurality of the memory devices simultaneously. The

Examiner has identified Christopher's PDA as being the claimed "host" and has identified Christopher's entire computer (including box 114, display 113 and cradle 120) as being the claimed "memory device". But nothing in Christopher teaches that his PDA have a slot for receiving and holding more than one Computer simultaneously.

If Applicants read the Office action correctly, the Examiner appears to point to a USB interface that has two connectors that connect to two devices. But Christopher's PDA is not taught as having a USB interface through which more than one Computer can be connected. Christopher's Computer might have such an interface, but that would be what the Examiner has identified as a Memory device receiving a plurality of Hosts simultaneously, which is the opposite of what is called for in the claim. Again, the Examiner is respectfully requested to reconsider this rejection.

As another example, **claim 22** depends from claim 18 and calls further for a cartridge for receiving the plurality of the memory devices simultaneously, the slot in the host being for receiving the cartridge. Again, however, the Examiner has identified Christopher's entire computer, including the cradle, as constituting Applicants' "memory device". Christopher nowhere suggests a cartridge that can hold a plurality of computers, much less one that meets the other limitations of this claim.

As another example, **claim 33** adds a limitation calling for a host to be operable to form a movie. Again, the Examiner has identified Christopher's PDA as constituting Applicants' "host", but has not cited any teaching that Christopher's PDA is operable to form a movie. The Examiner cites Christopher, col. 3, lines 46-51 as teaching this, but that excerpt says only that an SD card inserted into the PDA can carry video files (among other kinds of data files). It does not say that the PDA is operable to form such a video file, as called for in Applicants' claim. Nor does Christopher say that any PDA that he might have had in mind as of his filing date in 2001, even had a capability to form a video file. Applicants believe that the cited recitation in Christopher probably referred to video files written onto the SD card when it was previously inserted into another device. As such, it does not constitute a teaching of a "host" "operable to form a movie", as called for in Applicants' claim. Again, the Examiner is requested to reconsider this rejection.

As another example, **claim 35** adds a limitation calling for a host to be operable to form a video file. The points made above with respect to claim 33 apply to claim 35 as well.

Applicants have reviewed the grounds for rejection of the other dependent claims as stated by the Examiner and respectfully do not agree with the positions taken. Nevertheless Applicants do not believe it necessary to discuss their views on these claims further, due to the patentability of

independent claim 1 as set forth above. Applicants respectfully reserve the right to present their further points regarding these claims should it become necessary in the future.

Accordingly, claims 2-44 are believed to be patentable.

### C. Independent Claim 45

Claim 45 calls for a portable memory device having, among other things, a communications interface for establishing a communication link between the memory device and a plurality of different hosts at different times, at least one of the hosts being physically larger than the memory device.

In Applicants' Response A, Applicants pointed out that none of the devices in Christopher which the Examiner identified as constituting the claimed "hosts" (i.e. handheld computer 440, SD card and Multimedia card 432 or other devices of unspecified size connectable to the PC via bus 412), are "physically larger than" what the Examiner is calling the "memory device" (i.e. the combination of Christopher's computer box, CRT and cradle). Applicants also pointed out that *In re Rose* does not provide a basis to ignore this size limitation.

In response, the Examiner argues that limitations of being able to connect to hosts that are "larger" does not alter the "core function" of the device and therefore, *In re Rose* is still applicable.

Applicants respectfully incorporate their points from claim 1 above. There is no cognizable "core function" of a claim, and if there was, then the size limitation called for in claim 45 clearly qualifies as a "core function" in the aspect of the invention as claimed in claim 45. Again, one of the important functions of the claim is to be able to separate the portable memory device from its host (e.g. a digital camera) and carry it around to share with friends. If it were not physically smaller than the host, then there would not necessarily be any advantage to carrying it around separately. Thus if claims do have "core functions", this size limitation clearly does constitute one of them.

And when considering the claim as a whole, claim 45 is believed to have been unobvious over the cited art also because the Office action does not recite any motivation or any other reason why it would have been obvious to modify Christopher's desktop computer system to be physically smaller than his PDA. Absent such a reason or motivation, Applicants respectfully submit that the Office action fails to satisfy the requirement in *KSR* that an obviousness rejection set forth a clear articulation of the reason(s) why the claimed invention would have been obvious. MPEP 2142.



Without such a reason, the rejection fails to state a *prima facie* case of obviousness.

Accordingly, Applicants respectfully again submit that claim 45 should be patentable.

#### **D. Dependent Claims 46-73**

The Examiner rejected these claims as being obvious over various combinations of Christopher, Kaltenecker, and either Jones, Jeong or Torres.

These claims all depend ultimately from independent claim 45, and therefore are believed to be patentable for at least the reasons set forth above with respect to independent claim 45. In addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right.

The Examiner is respectfully referred to Applicants' discussion above with respect to the claims depending from claim 1, for reasons why corresponding ones of claims 46-73 should be patentable. For claims that do not correspond to a claim discussed above, Applicants have reviewed the grounds for rejection as stated by the Examiner and respectfully do not agree with the positions taken. Applicants do not believe it necessary to discuss their views on these claims further at this time, and respectfully reserve the right to present their further points regarding these claims should it become necessary in the future.

Accordingly, claims 46-73 are believed to be patentable.

#### **E. Independent Claim 74**

Claim 74 calls for, among other things, a controller operable to "determine a second image file format suitable for a second one of the hosts". The Examiner cites Kaltenecker col. 2, lines 28-61 as teaching this feature.

Claim 74 has now been amended to clarify that the second image file format suitable for a second one of the hosts is determined in dependence upon the second host itself.

Embodiments of this feature are described for example at paragraph [0050] of Applicants' specification, and two examples are elucidated in dependent claims 76 and 77.

Kaltenecker describes converting an image from one file format to another using a set of format rules that it retrieves for the second format, but the second format is not determined in dependence upon any second host.

Accordingly, it is respectfully submitted that claim 74 should now be patentable.

**F. Dependent Claims 75-91**

The Examiner rejected these claims as being obvious over various combinations of Christopher, Kaltenecker, and either Jones, Jeong or Torres.

These claims all depend ultimately from independent claim 74, and should therefore be patentable for at least the same reasons. In addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right.

The Examiner is respectfully referred to Applicants' discussion above with respect to the claims depending from claim 1, for reasons why corresponding ones of claims 75-91 should be patentable. For claims that do not correspond to a claim discussed above, Applicants have reviewed the grounds for rejection as stated by the Examiner and respectfully do not agree with the positions taken. Applicants do not believe it necessary to discuss their views on these claims further at this time, and respectfully reserve the right to present their further points regarding these claims should it become necessary in the future.

Accordingly, claims 75-91 are believed to be patentable.

**G. Independent Claim 92**

Claim 92, like claim 1, calls for the portable memory device (1) to be portable, and (2) to "fit within a bounding box having first and second parallel surfaces separated by no more than 10.5mm".

Like claim 1, claim 92 should be patentable both because the Examiner has not cited any reference teaching a memory device that is "portable", nor any reference teaching the size limitation recited in the claim.

Applicants respectfully incorporate their points from claim 1 above. For those reasons, it is respectfully submitted that claim 92 should be patentable for failure to state a *prima facie* case of unpatentability.

#### **H. Independent Claim 93**

Claim 93 calls for, among other things, a step of determining from a second host a second image file format suitable for the second host.

Claim 93 should be patentable for the same reasons as set forth above with respect to claim 74. In particular, while Kaltenecker describes converting an image from one file format to another using a set of format rules that it retrieves for the second format, the second format is not determined from any second host.

Accordingly, it is respectfully submitted that claim 93 should be patentable.

#### **I. Dependent Claims 94-99**

The Examiner rejected these claims as being obvious over various combinations of Christopher, Kaltenecker, and either Jones, Jeong or Torres.

These claims all depend ultimately from independent claim 93, and should therefore be patentable for at least the same reasons. In addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right. The Examiner is respectfully referred to Applicants' discussion above with respect to the claims depending from claim 1, for reasons why corresponding ones of claims 94-99 should be patentable. For claims that do not correspond to a claim discussed above, Applicants respectfully do not agree with the positions taken in rejecting them, but do not believe it necessary to discuss their views on these claims further at this time, and respectfully reserve the right to present their further points regarding these claims should it become necessary in the future.

Accordingly, claims 94-99 are believed to be patentable.

#### **J. Independent Claim 100**

Claim 100 calls for, among other things, a portable memory device:

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm,

and wherein the display fills a major surface of the device.

Regarding the limitation that the portable memory device fit within a bounding box of

specified dimension, Applicants respectfully incorporate their points set forth above with respect to claim 1.

Regarding the limitation that the display "fill a major surface" of the device, Applicants' Response A pointed out that nothing in either Christopher or Kaltenecker appears to teach or suggest this feature in any way.

In the new Office action, the Examiner argues that the extent to which the display fills a surface is not a "core function" of the device. Again, however, the Examiner cannot ignore a claim limitation based on his own view of which limitations are "core" and which are not. All limitations in a claim must be considered in the "claim as a whole" analysis, no limitation being any more or less important than any other. *W.L. Gore & Associates*, cited above.

Since the new Office action still fails to cite a reference in which the display "fills a major surface", nor recites any reason or motivation why it would have been obvious to so modify the displays in the references that are cited, Applicants respectfully submit that the claim should be patentable for failure to state a *prima facie* case of unpatentability.

**K. Dependent Claim 101**

Claim 101 should be patentable for at least the same reasons as its parent claim 100.

**L. Independent Claim 102**

Claim 102 calls for, among other things, a portable memory device:

wherein the portable memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm, ...

and wherein the display fills said major surface except for a border no wider than 1/16 the size of said minor dimension.

Applicants respectfully incorporate their points set forth above with respect to claim 1. Accordingly, claim 102 should be patentable.

**M. Dependent Claim 103**

Claim 103 should be patentable for at least the same reasons as its parent claim 102.

## II. NEW CLAIM

The new claim is added to more particularly point out an aspect of the invention.

It is noted that the new claim calls for, among other things, interface means, operable while the memory device is in communication with the host device, for communicating data information with the host device in response to read and/or write signals from the host device. (emphasis added).

Nothing in Christopher indicates that his PDA had the capability to send read and/or write signals to a tethered computer system.

## III. OTHER MATTERS AND CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The fees for one new claim, and for an appropriate Extension of Time, are submitted with this Response.

Applicant believes no other fee is due with this response. However, the Commissioner is authorized to charge any fee or credit any overpayment related to the present submission to our Deposit Account No. 50-0869, under Order No. JMZ 1000-IUS from which the undersigned is authorized to draw.

Dated: 6 July 2009

Respectfully submitted,

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